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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
DESAI, ANISH P	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,078	WENNINGER ET AL.	
	Examiner	Art Unit	
	Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/11/03&909/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12 and 13 relate to method of using the claimed adhesive tape, however the applicant has not recited any steps, which he or she is using in order to accomplish the claimed method. For the purpose of the examination of the claims 12 and 13, the examiner is interpreting that any adhesive tape that meets the structural and compositional requirements of the claimed adhesive tape is suitable for performing the claimed method.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Skoglund et al (US Patent 5,716,701).

3. Skoglund et al. teach a normally tacky and pressure-sensitive water-borne adhesive composition suitable for application to plasticized polyvinyl chloride film

(Column 1, lines 5-10). The pressure sensitive adhesive are used in many applications such as decorative vinyl laminations, decals, signage, and specialty tapes (Column 1, lines 18-21). Moreover, Skoglund et al. disclose an aqueous acrylic emulsion pressure-sensitive adhesive containing styrene in the example 1. Additionally, in the example 1, Skoglund state that a jacketed Pyrex reactor equipped with nitrogen purge, stirrer, and addition ports was charged with deionized water which was heated to 80°C. A monomer emulsion was prepared. The initiator was added to the reactor and the monomer emulsion was added at a constant rate over three-hour period. The resulting emulsion polymer was held at 85°C for one hour and then cooled to 30°C (Column 3, lines 15-22). Thus, the monomer emulsion is crosslinked using heat. The thickness of the vinyl film of Skoglund et al. is 3 mil (Column 4, lines 20-23), which equates to 76 micrometer (using 1 mil = 25.4 micrometer).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skoglund et al. (US Patent 5,716,701) or in alternative in view of the Applicant's Admitted Prior Art.

5. The invention of Skoglund et al. is previously disclosed. Although, Skoglund et al. do not explicitly teach the claimed styrene fraction but in the example 1 Skoglund et al. disclose the various amount of chemical species (e.g. styrene, RHODAPEX CO -436 etc.) that are used in the formulation of the pressure sensitive adhesive. The examiner has calculated the styrene fraction in the pressure sensitive adhesive formulations in the Example 1 of Skoglund et al. using the following method. First the total amount of all of the chemical species (i.e. Deionized water in Reactor charge, Deionized water in the monomer emulsion, RHODAPEX CO-436, Aqua Ammonia 29%, Acrylic Acid, 2-Ethylhexyl Acrylate, n-Butyl Acrylate, styrene, Ammonium Persulfate, Rinse deionized water) in grams was calculated by adding the individual amount of said chemical species. The total amount of all of the chemical species was 2,999.9 grams. Then, the amount of styrene (130.4 grams) was divided by the said total amount of chemical species (i.e. 2,999.9 grams) and then the resulting fraction was multiplied by 100 to obtain the styrene fraction. The styrene fraction using aforementioned method was 4.34%. Skoglund et al. teach the claimed invention except that the claimed styrene fraction. The styrene fraction is considered to be a result effective variable. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed styrene fraction, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Alternatively, it seems that the applicant has disclosed in the Background of the Invention that aqueous systems based on styrene-acrylate copolymers are known.

Depending on the styrene fraction of the copolymers the materials in hardness, the styrene fraction normally used being between 30% to 60% (Page 5, Specification, lines 9-14). Thus a skilled artisan would have found it obvious to use known styrene fraction in the invention of Skoglund et al., motivated by the desire to obtain the pressure sensitive adhesive composition with suitable hardness.

7. Claims 3 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skoglund et al (US Patent 5,716,701) in view of Schwarcz (US Patent 4,002,794).

8. The invention of Skoglund et al. is previously disclosed. Skoglund et al. are silent with respect to teaching adhesive is applied to the PVC sheet in the amount of 10 to 50 g/m^2 as claimed in the claim 3, adhesive layer contains up to 50% by weight of at least one resin dispersion as claimed in the claim 5, adhesive layer contains up to 60% by weight of at least one dispersion as claimed in the claim 6, adhesive layer contains up to 40% by weight of at least one monnomeric or polymeric plasticizer or oil as claimed in the claim 7, primer layer as claimed in the claim 8, and a release layer as claimed in the claim 9.

9. Schwarcz teaches novel copolymeric materials suitable for use as a release agent or as a component in a release composition, and to methods of their preparation. In more particularly the invention relates to coated substrates having a surface coated therewith such as release liner and pressure sensitive adhesive tapes (Column 1, lines 6-13).

10. With respect to the claim 3, in addition to previously disclosed matters of Schwarcz, the weight of the pressure sensitive adhesive composition of Schwarcz is

backing member (Column 12, lines 33-36) which equates to 16.95 grams per square meter to 136 grams per square meter (using 1 ounce = 28.35 grams and 1 square yard = 0.836 square meter). Thus a skilled artisan would have found it obvious to apply the adhesive of Skoglund et al. using the disclosed weight of Schwarcz, motivated by the desire to produce a pressure sensitive adhesive tape.

11. With respect to the claims 5-8, in addition to previously disclosed matters of Schwarcz, the pressure sensitive adhesive composition can comprise any elastomeric materials such as natural or synthetic rubber, examples of which include butadiene and styrene and polyacrylates. The adhesive composition includes tackifying agents such as hydrocarbon resins and polymerized or disproportionated rosin esters. Additionally, the resin composition includes plasticizers such as mineral oil, lanolin, liquid polybutenes or polyacrylates (Column 11, lines 28-51). Schwarcz teaches the claimed invention except for the claimed weight percent of the resin dispersion as claimed in the claim 5, claimed weight percent of the dispersion as claimed in the claim 6, and the claimed weight percent of the plasticizer or oil as claimed in the claim 7. The claimed weight percent is considered to be result effective variable. For example, as the amount of tackifying agent increases the tack of the adhesive improves. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed weight percent of the resin dispersion as claimed in the claim 5, claimed weight percent of the dispersion as claimed in the claim 6, and the claimed weight percent of the plasticizer or oil as claimed in the claim 7, since it has been held

that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. Regarding the claim 8, Schwarcz teaches a primer coating on the backing before the adhesive composition is applied to the backing (Column 12, lines 17-20) in order to improve the surface bonding characteristic of the backing to the pressure sensitive adhesive (Column 11, lines 16-20). Thus, a skilled artisan would have found it obvious to use a primer layer of Schwarcz and applied it on the plasticized polyvinyl chloride film of Skoglund et al before the application of adhesive, motivated by the desire to improve the bonding between the adhesive and the film.

13. With respect to the claim 9, Schwarcz teaches that a coating known as release coat or back size is generally provided on the back side of the tape backing member i.e. the side opposite that on which the adhesive mass is applied in order for easy to unwind the tape when it is provided in the roll form (Column 1, lines 15-28). Thus a skilled artisan would have found it obvious to use a release coating of Schwarcz in the pressure sensitive adhesive tape of Skoglund et al. in order to easily unwind the tape from the roll.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skoglund et al (US Patent 5,716,701) in view of Glennon (US Patent 4,311,759).

15. The invention of Skoglund et al. is previously disclosed. In addition to previously disclosed matters of Skoglund et al., a wetting agent is disclosed by Skoglund et al. (Column 3, line 30). Skoglund et al. are silent with respect to teaching antifoaming agents and ageing inhibitors.

16. Glennon teaches a pressure sensitive adhesive composition. The pressure sensitive composition of Glennon includes anti-oxidants to avoid the degradation of adhesive by oxidation (Column 6, lines 55-56) and antifoam agent to prevent the degradation of the adhesive (Column 5, lines 65-68, column 6, lines 1-5). Thus a skilled artisan would have found it obvious to use the anti-oxidants and antifoam agent of Glennon in the adhesive composition of Skoglund et al., motivated by the desire to decrease the degradation of the adhesive. The examiner is equating the anti-oxidants of Glennon as the claimed ageing inhibitors.

17. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skoglund et al (US Patent 5,716,701).

18. With respect to the claims 12 and 13, it is examiner's position that the adhesive tape of Skoglund et al. is functionally capable of bunding, protecting, labeling, insulating or sealing ventilation pipes or wires or cables as claimed in the claim 12 and functionally capable of being used in sheathing of cable looms and filed coils as claimed in the claim 13. Because the adhesive tape of Skoglund et al. has an aqueous acrylic emulsion pressure sensitive adhesive with styrene coated onto a plasticized polyvinyl chloride film.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

ELIZABETH M. COLE
PRIMARY EXAMINER